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**REMARKS**

Claims 1-13 are currently pending in the above application. Applicants herein confirm cancellation of claims 14-21 without prejudice in response to Examiner's restriction requirement.

Claim 8 is objected to under 35 U.S.C. §112, second paragraph, as being indefinite because Applicant has not provided a copy of the procedure used to measure water vapor transmission rate. Claim 13 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for the use of the trademarks Papermatch® in connection with "dispersion". Claims 1-13 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite because the phrase "regular" is believed to be indefinite.

Claims 1, 3-5, and 11-12 stand rejected under 35 U.S.C. 102(e) as being anticipated by as being anticipated by Gundberg et al. (U.S. Patent No. 6,203,646). Claim 2 stands rejected under 35 U.S.C. 102(e) as being anticipated by as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as being obvious Gundberg et al. Claims 6 and 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gundberg et al., as applied to claims 1, 3-5, and 11-12 above, and further in view of Penz et al. (U.S. Patent No. 5,888,913). Claims 9, 10, and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gundberg et al., as applied to claims 1, 3-5, and 11-12 above, and further in view of Melber et al. (U.S. Patent No. 4,898,892).

**Rejection of claim 8 under 35 U.S.C. §112, second paragraph**

Claim 8 stands rejected as being indefinite because Applicant has not provided a copy of the procedure used to measure vapor transmission rate. Applicants respectfully traverse the Examiner's rejection, noting that the standard in use is widely known to those of ordinary skill in the art. However, in an attempt to move this case towards allowance,

Applicants will provide a copy of the standard. Reconsideration of claim 8 is respectfully requested.

**Rejection of claim 13 under 35 U.S.C. §112, second paragraph**

Claim 13 stands rejected under 35 U.S.C. 112, second paragraph, for the alleged improper use of the trademark Papermatch® in conjunction with "dispersion". Applicants note that the use of the trademark Papermatch® in connection with the word "dispersion" is proper, in that the trademark is not being used alone to describe the goods, citing *Ex Parte Simpson*, 218 USPQ 1020 (Bd. App. 1982).

However, in an attempt to move this case towards allowance, Applicants have further modified claim 13 to include "wherein said Papermatch® dispersion comprises a dispersion of ground calcium carbonate and ground titanium dioxide in high density polyethylene". It is respectfully submitted that this change satisfies the requirements of 35 U.S.C. 112, second paragraph. Reconsideration of claim 13 is respectfully requested.

**Rejection of claims 1-13 under 35 U.S.C. §112, second paragraph**

Claims 1-13 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite due to the use of the phrase "regular". Applicants respectfully disagree, noting that the term "regular" was used to describe the surface on page 7, first full paragraph, line 3 in the context of a regular, paintable surface and is described throughout the specification in terms of smoothness, porosity and paintability. As defined throughout the specification, for instance of page 3 of the specification, the polymeric coating is described as having reduced porosity as compared with the underlying mat structure yet having a degree of gas permeability to allow moisture to escape. In addition, as shown on Figures 2 and 3, the polymeric coating 50 is illustrated as being relatively smooth along a surface opposite the fiber tissue. This fact is confirmed by the introduction of a mineral filler is added to the polymeric material, wherein the addition is described on page 3 of the specification as adding structure to the polymer surface, therein allowing a roller applicator to move across

the outer surface without significant slippage. These facts, taken together, illustrate that the term "regular" and "relatively smooth" may be used interchangeably in the present application, and are understood to be interchangeable to persons of ordinary skill in the art.

Thus, Applicants respectfully submit that the term "regular" is not indefinite. However, in an attempt to more clearly distinguish over the Gundberg reference, Applicants will replace "regular" with "relatively smooth." As the Figures show the polymeric surface as being relatively smooth, and as the specification adequately describes the surface as being relatively smooth, Applicants respectfully submit that the modification is supported by the specification and overcomes any indefiniteness rejections. Reconsideration of claims 1-13 is respectfully requested.

**Rejection of claims 1, 3-5 and 11-12 under 35 U.S.C. §102(e)**

Claims 1, 3-5 and 11-12 stand rejected as being anticipated by Gundberg (U.S. Patent No. 6, 203,646). Applicants respectfully traverse the Examiner's rejection.

Gundberg discloses a fibrous thermoplastic netting layer adhered around at least a part of the surfaces of a mineral fiber base layer for use as thermal and acoustic insulation (see Column 1, lines 18-19 and Column 9, lines 50-51). As shown in Figure 1, the netting 13 is formed basically as a coating of fibers and/or filaments to the underlying mat structure to provide additional thermal and acoustical properties to the fibers.

The present invention, on the other hand, as in modified claim 1 (and dependent claims 2-13), describes a polymeric wall covering material, not an insulating material, having a thermoplastic coating material applied to the non-woven fiber tissue to provide a relatively smooth, paintable visible outer surface. As one of ordinary skill appreciates, a relatively smooth, paintable visible outer surface would allow paint or other surface

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enhancements to be applied to the outer surface more easily, therein improving the aesthetic characteristics of the fiber reinforced wall covering. A similar type surface enhancement would not be considered or even necessarily desired in an insulating material, which is typically not visible in actual use. In addition, the polymeric coating in the presented claims is not a polymer melt in the form of fibers and/or filaments as in Gundberg, but is simply a polymer melt forming a relatively smooth and paintable outer surface.

In Examiner's remarks listed on page 3 of the Office Action, the Examiner notes that the reference teaches the use of the same thermoplastic polymer materials. However, as stated previously, this point is irrelevant, because the materials are not being used to form a coating having a relatively smooth and paintable outer surface, instead they are being used to form a netting over the matting to provide additional thermal and acoustical properties and to prevent fiber loss before, during and after installation. Applicants can think of thousands of instances wherein a similar material is used to form an article. For example, a polyester material can be used in an automotive base coat and in a fabric used for clothing, yet an Examiner would not reject a polyester base coat claim with a polyester fabric reference.

As such, modified claim 1, and dependent claims 3-5 and 11-12 are not anticipated by Gundberg. Reconsideration of claims 1, 3-5 and 11-12 is thus respectfully requested.

**Rejection of claim 2 under 35 U.S.C. §102(e) or, alternatively, under §103(a)**

Claim 2 stands rejected under 35 U.S.C. §102(e) or, alternatively, under §103(a). As described above, modified claim 1 is not anticipated by Gundberg. As such, dependent claim 2 is similarly not anticipated by Gundberg.

As indicated above, the fibrous thermoplastic netting layer adhered to a mineral

fiber base layer in Gundberg is used as an insulator, not a polymeric wall covering, and is therefore used to improve the acoustical and thermal properties of the mineral fibers. The coating also helps to minimize the release of fibre wads or single fibers to the surroundings before, during and after mounting. It does not create a paintable surface, especially a surface that can be easily painted with rollers.

Surface tension, as one of ordinary skill appreciates, is important when adhering one substance to another like, for example, when adhering paint to an outer surface of a material. In the case of Gundberg, there would be no reason to paint the outer surface of the netting layer which is used as an insulator, whereas in claim 1 it is important for the surface tension to be such to allow paint to easily adhere to the outer visible surface. Further, painting the fibers and or filaments in Gundberg with a roller to obtain a pleasing aesthetic surface would be highly impractical, if not impossible to form a pleasing aesthetic surface. The roller would have to be manipulated in such as way as to coat each nook and cranny.

Claim 2 is therefore non-obvious in view of the cited prior art. Reconsideration of claim 2 is respectfully requested.

**Rejection of claim 6 and 7 under 35 U.S.C. §102(e) or, alternatively, under §103(a)**

Claims 6 and 7 stand rejected as being unpatentable over Gundberg, as applied to claims 1, 3-5, and 11-12 above, as applied to Penz et al. (U.S. Patent No. 5,888,913). Applicants respectfully traverse the Examiner's rejection.

Section 2143 of the Manual of Patent Examining Procedure states that three basic criteria must be met for establishing a *prima facie* case of obviousness, stating:

"First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach all of the claim limitations."

"If the examiner does not establish a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Section 2142 MPEP, ch. 2100, p. 110. "When the references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned."<sup>1</sup> One cannot use hindsight reconstruction, picking and choosing among isolated disclosures in the prior art, to deny that the claimed invention is unobvious.<sup>2</sup>

Penz et al. discloses a glass mat reinforced thermoplastic suitable for the production of paintable parts comprising a thermoplastic matrix polymer, one or more glass mats, and a fine-particle mineral fiber.

It would not be obvious to combine the Gundberg reference and the Penz et al. reference to arrive at the present invention. No reason is shown why one of ordinary skill in the art would modify the Gundberg reference as the Office Action proposes. Here, the Examiner is utilizing Penz to include a mineral filler in the chemical composition of the polymeric fiber coating of Gundberg as is presented in claims 6 and 7. This would result in mineral filler containing polymeric material in strand or filament form coupled to the underlying mat structure in the form of a net coating. Applicants respectfully suggest that there would be no motivation to combine Gundberg and Penz to arrive at the present invention as in present claims 6 and 7, as the addition of mineral filler to the composition of Gundberg would still not result in a relatively smooth, easily paintable outer surface

<sup>1</sup> In re Ochiai, 71 F.3d 1565, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995), citing In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

<sup>2</sup> In re Fine, 837 F.2d at 1075.

(especially with a roller application) as in claims 6 and 7.

In Examiner's remarks listed on page 3-4 of the Office Action, the Examiner notes that acoustic insulation materials "are known to be used as wall panels". This is not an entirely accurate statement. Acoustic insulation materials are typically used within a wall panel to provide additional thermal and acoustical protection (i.e. as a portion of the wall panel), but are not typically used as the wall panels themselves. A wall panel typically includes other materials, such as asbestos cement sheets, plywood, and gypsum plasterboards. Thus, while the wall panel may include acoustical and or thermal insulation, it is not made entirely of those materials, and thus the proposition that acoustic insulation materials in the form of wall panels that are easily paintable is not correct. Even assuming that they are, the structure of Gundberg with the addition of the mineral filler of Penz would still not result in a relatively smooth, easily paintable outer visible surface as described in the previous paragraph.

Hence claims 6 and 7 are not obvious in view of the cited prior art. Reconsideration of claims 6 and 7 is respectfully requested.

**Rejection of claim 9, 10, 13 under 35 U.S.C. under §103(a)**

Claims 9, 10 and 13 stand rejected as being unpatentable over Gundberg, as applied to claims 1, 3-5, and 11-12 above, and further in view of Melber (U.S. Patent No. 4,898,892). Applicants respectfully traverse the Examiner's rejection.

Melber discloses a method for making an opaque coating comprising employing opacifiers into or onto the surface of thermoplastic microspheres.

It would not be obvious to combine the Gundberg reference and the Melber et al. reference to arrive at the present invention. No reason is shown why one of ordinary skill

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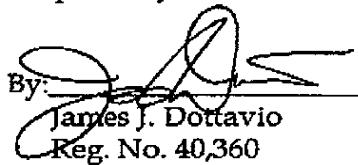
in the art would modify the Gundberg reference as the Office Action proposes. As stated previously with regards to mineral fillers, the addition of an opacifying agent of Melber to the polymeric netting coating of Gundberg would still not result in a relatively smooth, paintable outer visible surface of a polymeric wall covering material as in claims 9, 10 and 13. As such, there would be no reason to combine the opacifying enhancement characteristics described in the Melber reference with Gundberg to arrive at claims 9, 10 and 13 as the Office Action proposes.

Hence, claims 9, 10 and 13 are not obvious in view of the cited prior art. Reconsideration of claims 9, 10 and 13 is respectfully requested.

#### CONCLUSION

In view of the foregoing amendments and remarks, Applicant submits that claims 1-13 are in proper form and allowable over the cited prior art. The Examiner is invited to telephone the Applicants' undersigned attorney at (614) 321-7162 if any unresolved matters remain.

Respectfully submitted,

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